

## **REMARKS**

These amendment and remarks are being filed in response to the Office Action mailed June 19, 2008 (the "Office Action"). At the time of the Office Action, claims 1-9 were pending. The Office Action rejected claims 1-9 under one or more of 35 U.S.C. §112, second paragraph, and 35 U.S.C. §103, and rejected the Abstract for failure to use clear and concise language. By this Amendment, claims 1, 2 and 6-9 and the Abstract are amended, claims 3-4 are canceled, and claims 10-14 are added. No new matter is added. The rejections and response thereto are set forth fully below.

### **Amendments to the Specification**

In the Office Action, the Abstract is objected to for failing to use clear and concise language. By this Amendment, Applicants address the issues identified in the Office Action. Accordingly, Applicants respectfully request that the objection to the Abstract be withdrawn.

In addition, paragraphs [0012] and [0020] include typographical errors where the "W" and "O" for the claimed W/O silicone system were transposed. Accordingly, paragraphs [0012] and [0020] are amended to properly reflect the claimed subject matter of a W/O emulsion.

### **Claims Rejections – 35 U.S.C. § 112, second paragraph**

In the Office Action, claims 1-9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action identifies a number of issues in claims 1 and 6-8. By this Amendment, claims 1 and 6-8 are amended. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

### **Claims Rejections – 35 U.S.C. § 103**

In the Office Action, claims 1, 3 and 4 are rejected under 35 U.S.C. §103(a) as being unpatentable over Swiss Patent No. 258 982 issued to CIBA (hereinafter "Ciba"), Japanese Publication JP 2003/049912 filed by Honda *et al.* (hereinafter "Honda"), French Patent No. 2 837 705 issued to Chevalier (hereinafter "Chevalier"), Japanese Publication JP 2004/010526

filed by Hoshino *et al.* (hereinafter "Hoshino") and German Patent No. 3 319 764 issued to Rises & Co (hereinafter "Rises").

Applicants wish to review the claims, as set forth in independent claim 1:

1. (Currently amended) An anti-wrinkle cosmetic comprising the following ingredients in a water/oil silicone oil system

0.05 to 3.0% by weight (w/w) of an extract from *Papaver*,  
0.05 to 2.0% by weight (w/w) of an extract from *Passiflora*,  
0.05 to 3.0% by weight (w/w) of an extract from *Mentha*,  
0.05 to 3.0% by weight (w/w) of an extract from *Myrtus*,

wherein a remainder of the anti-wrinkle cosmetic comprises in addition to usual cosmetic auxiliaries, carriers, active agents or mixtures thereof, which make up the remainder up to 100 %

wherein said extract from *Papaver* is an extract from the seeds of *P. adulis*, *P. rhoeas*, *P. incarnata*, *P. laurifolia*, *P. quadrangularis*, *P. somniferum* or mixtures thereof, and

wherein said extract from *Mentha* is an extract from *M. aquatica*, *M. arvensis*, *M. piperita*, *M. pulegium*, *M. rotundifolia*, *M. viridis* or mixtures thereof.

The claimed subject matter is drawn to a cosmetic composition containing a unique mixture of specific *Papava* seed extract, specific *Mentha* extract, *Passiflora* extract and *Myrtus* extract that produces unexpected moisturizing and anti-wrinkle effect. Each of the relevant extracts are aqueous or alcoholic extracts produced at a temperature of 20-50°C, not essential oils produced through steam distillation. The cosmetic composition is a water-in-water silicone oil system. Thus, each of the extracts is found in the same phase of the water-in-oil silicone oil system.

The claimed subject matter was discovered only after identifying a unique combination of four extracts selected from vast array of possible cosmetic ingredients extracts using a specific set of conditions. The claims are further limited to six of the more than 120 *Papaver* species and six of the more than 25 *Mentha* species. The claimed combination exhibits an improved anti-wrinkle effect that is neither disclosed nor suggested by the cited references, or any other references known to the Applicants. Thus, contrary to the assertions of the Office Action, the claimed subject matter is an unexpected development in the field and not a matter of mere optimization.

Turning now to the cited references. Ciba is drawn to a skin-care product that includes nicotinic acid amide and a substance with Vitamin F action. The Ciba product is designed to sustain skin in its normal state. See Ciba Translation, p. 2, 1<sup>st</sup> full paragraph. In particular, Ciba is drawn to a synergistic effect of several specific substances having a Vitamin-F effect, including *Papaver* oil, and nicotinic acid amide. See Ciba Translation, p. 2, 2<sup>nd</sup> and 3<sup>rd</sup> full paragraphs.

Applicants note three primary deficiencies with this reference. First, the reference refers to *Papaver* oil, which one of ordinary skill in the art would understand as referring to a pressed oil or an essential oil produced using steam distillation. In either case, Ciba does not disclose the claimed extract obtained from *Papaver* using a polyvalent alcohol at 20-50°C. Second, in the original German, the reference refers to *Papaver* oil (rather than poppy seed oil), thus it is not clear that the source of the papaver oil is the seeds. Finally, the objective of Ciba is to "sustain the skin in its normal state," not to eliminate pre-existing wrinkles. See Ciba Translation, p. 1, 1<sup>st</sup> paragraph. Thus, there would be no motivation to combine the Ciba reference with any other reference in order to develop the any cosmetic composition having an anti-wrinkle effect, much less the claimed combination of four extracts.

The Chevalier reference is drawn to a complex of essential oils and cosmetic products incorporating the complex of essential oils. The Chevalier essential oil complex that includes myrtle with myrtenyl acetate is for treating "cellulite and heavy leg" and rosacea. See Chavalier Translation, p. 5, ln. 18 – p. 6, ln. 12 & p. 11, ln. 6 – p. 12, ln. 13. In contrast, the embodiment of Chavalier focusing on anti-wrinkle applications does not include myrtle with myrtenyl acetate. See Chavalier Translation, p. 6, ln. 13 – p. 7, ln. 10.

Thus, Chevalier teaches away from the claimed subject matter for at least three reasons. First, the Chavalier discloses an essential oil produced from steam distillation or cold press, but does not disclose or suggest the claimed *Myrtus* extract comprising an alcohol that is obtained from *Myrtus* flowers at 20-50°C. Second, Chavalier does not disclose or suggest that an essential oil of myrtle with myrtenyl acetate, much less the claimed alcoholic myrtle extract, would be useful for producing an anti-wrinkle effect. Finally, the claimed subject matter does not include myrtenyl acetate.

The Hoshino reference refers to cosmetic compositions containing steam distillates of numerous plants, including mint. *See* Hoshino Translation, paragraph [0001]. The cosmetic composition provides a "skin-beautifying use that ha[s] ameliorating effects on the dullness and clearness of the skin." *See id.* The steam distillates are the water layer portion separated from the essential oil layer following the steam distillate process. *See* Hoshino Translation, paragraph [0004] & [0035]. This is distinguishable from the claimed aqueous *Mentha* extract obtained at 20-50°C.

The Honda reference is directed to an elastase inhibitor that contains a solvent extract of passion flower. *See* Honda Translation, claim 1. Honda indicates that any part of the *Passiflora incarnate* that extends above the surface of the ground can be used for the extract.

Finally, the Riese reference is drawn to a cosmetic composition containing a water-in-oil emulsion where 25 to 50% of the grease in the outer phase is replaced by volatile silicone oil. *See* Riese Translation, p. 4, 4<sup>th</sup> full paragraph. This substitution avoids the undesirable "grease luster" of prior art approaches by replacing the grease phase with silicone oil, which does not form grease. *See* Riese Translation, p. 3, last paragraph & p. 5, 2<sup>nd</sup> full paragraph. Thus, Riese does not address any aspect of the effect of the claimed subject matter or, in particular, the unexpected benefits of the claimed combination of aqueous and alcoholic extracts.

With respect to the unexpectedly superior results of the claimed mixture, *In re Chupp*, 816 F.2d 643 (Fed. Cir. 1987) is particularly relevant. In *In re Chupp*, The Federal Circuit held that evidence that a compound or composition possesses superior and unexpected properties in one of a spectrum of common properties can be sufficient to rebut a *prima facie* case of obviousness, *see In re Chupp*, 816 F.2d 643, 646 (Fed. Cir. 1987); MPEP 2145.

In *In re Chupp*, the claims at issue were drawn to a compound for use as a selective herbicide with unexpectedly superior herbicidal efficacy for soybeans and corn, but average herbicidal results for other crops, *see id.* at 644. The prior art was a homolog of the claimed compound that differed from the claimed compound by a single methylene group (C=C), and was disclosed as being a selective herbicide for crops generally. Thus, the difference between the claimed compound and the prior art was a single methylene group and an unexpected improvement in herbicidal efficacy that was limited to two crops.

The Court noted that the claimed compound's "superior activity in corn and soybeans is a new and unexpected property," *In re Chupp*, 816 F.2d at 645. The Commissioner argued that the claimed compound was similar to the prior art and provided average selective herbicidal activity for many crops and poor herbicidal activity for others. ***The Federal Circuit responded to this argument by concluding that the fact that a compound or composition possesses superior and unexpected properties in one of a spectrum of common properties was sufficient to rebut a prima facie case of obviousness, see id. at 646.***

In this respect, Applicants draw the Examiner's attention to the unexpected synergistic results described in Examples 5 and 6 of the Specification, which address the claimed composition's long-lasting moisturizing effect and anti-wrinkle effect, respectively. In Example 5, the moisture in the skin of 18 female test persons with dry mixed skin was measured using a Corneometer 825 (Courage & Khazaka, Germany) at 22°C and 56 % relative air humidity. Three different creams were applied: Example 1 (claimed extracts), Example 2 (claimed extracts and hexapeptide), and Example 1 without extracts (identical to Example 1 without the claimed combination of extracts). *See* Specification, p. 7, ln. 19 – p. 9, ln. 4. Each of the creams was applied 2 hours after the skin had been cleansed. The following table shows the results as regards moisturizing in % as average values.

TABLE 1

Time	Cream of Example 1		Cream of Example 2a		Cream of Expl. 1 without extracts	
	Average	Increase	Average	Increase	Average	Increase
before	42.5	—	40	—	42.5	—
0.5 h	58	+36%	51	+28%	52	+22%
2 h	58	+36%	53	+33%	53	+24%
6 h	56	+32%	54	+35%	52	+22%
24 h	60	+41%	—	—	45	+5%
2 weeks	62	+45%	59	+48%	—	—
4 weeks	65	+53%	63	+54%	—	—

The comparison shows that the cream according to Example 1 of the present invention containing the claimed extracts has a moisturizing effect which is noticeably better than that of a cream without this complex. Cream 1 without extracts showed an increased moisture value after 8 hours, but fell to nearly zero after 24 hour. In contrast, the inventive creams of Examples 1 and

2a had average increased moisture values of at least 45% after 2 weeks. These moisture improvements remained even 4 weeks after application of the claimed combination of extracts. Clearly, there is nothing in the cited references or elsewhere that suggests such a drastic increase in skin moisturizing effect after such a prolonged period. This is strong evidence of an unexpected result that argues against obviousness.

Applicants now turn to the unexpected results with respect to the anti-wrinkle effect of the claimed mixture of extracts. The test included 21 male and female test persons aged between 42 and 61 years. A microrelief of parts of the facial skin (eye area, corners of the mouth, nose area) was taken using a silicone mass, said mass was left to harden and the negative relief obtained was measured electrooptically as regards the depth and number of wrinkles. Immediately after the microrelief had been taken, a cream was applied to the face of the test persons for the first time, which cream was then applied repeatedly twice a day in an amount of approx. 2 g/cm<sup>2</sup>. The test subjects were broken into three groups and one of the three compositions used to compare moisturizing-effect above was assigned to each group as follows:

- Group 1: treated with the cream of Example 1;
- Group 2: treated with the cream of Example 2a;
- Group 3: treated with a cream which consisted only of the  
basic formulation of Example 1 without active agents (placebo).

Control measurements were carried out on the 14th and 28th day after the first measurement by taking the microrelief of the same skin areas of the individual test persons. During this time, no test person was subjected to particularly intense solar radiation. The values determined are statistical average values for a selected area of the microrelief.

	Number of test persons		
	Group 1	Group 2	Group 3
Reduction of wrinkle depth after 14 days			
by 10-30%	8	4	1
by 30-50%	4	—	—
Reduction of wrinkle depth after 28 days			
by 10-30%	2	1	1
by 40-50%	7	3	—
>50%	2	2	—

Each of the individuals using the inventive compositions, *i.e.*, Groups 1 and 2, experienced measurable reductions in wrinkle depth after 28 days. In addition, Group 1 showed a very good reduction of the wrinkle depth after 28 days for over 75 % of the test persons (9 of 11). The individuals of Group 2 showed an even higher rate of improvement with nearly 85% of the test persons (5 of 6) showing very good reduction of wrinkle depth after 28 days. This additional improvement can be attributed to the interaction of the claimed extract mixture with the hexapeptide. In contrast, none of the Group 3 individuals experienced very good wrinkle depth reduction after 28 days and only 33% showed any measurable wrinkle depth reduction after 28 days.

This substantial improvement is clear evidence of the unexpected improvement in anti-wrinkle effect produced by the claimed combination of extracts. Accordingly, Applicants respectfully submit that this improvement is strong evidence against a conclusion of obviousness.

As further evidence of non-obviousness, Applicants note that there is a long felt, but unresolved need for a cosmetic that provides an anti-wrinkle effect and long-lasting moisturizing. *See* MPEP 716.02. This problem is older than patent law itself and was not solved at the time the instant application was filed. The long standing nature of this problem is also supported by the fact that Ciba was published nearly 60 years ago and Riese was published 20 years ago. This reinforces the unexpected nature of the results described above and constitutes strong evidence of non-obviousness.

The Office Action also asserted the following rejections:

(A) claims 1-4 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ciba, Honda, Chevalier, Hoshino and Rises, further in view of Passerini, "Antiaging Synthetic Hexapeptides," COSMETIC TECHNOLOGY, page 37-39 (2002) (hereinafter "Passerini");

(B) claims 1, 3, 4 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ciba, Honda, Chevalier, Hoshino and Rises, further in view of U.S. Patent No. 6,426,080 issued to Golz-Berner *et al.* (hereinafter "Golz-Berner");

(C) claims 1, 3, 4, 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ciba, Honda, Chevalier, Hoshino and Rises, further in view of U.S. Patent Application Publication No. 2004/0091439 issued to Kamei *et al.* (hereinafter "Kamei"), as evidenced by Sakuta (U.S. Patent Application Publication No. 2004/0241126); and

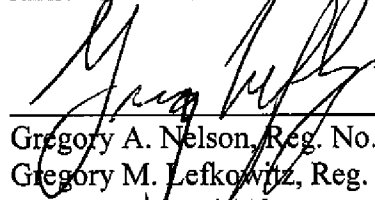
(D) claims 1, 3, 4 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ciba, Honda, Chevalier, Hoshino and Rises. As none of the new references correct the deficiencies of Ciba, Honda, Chevalier, Hoshino and Rises described above, Applicants respectfully request that these rejections also be withdrawn.

### **Conclusion**

For at least the reasons set forth above, the independent claims are believed to be allowable. In addition, the dependent claims are believed to be allowable due to their dependence on an allowable base claim and for further features recited therein. The application is believed to be in condition for immediate allowance. If any issues remain outstanding, Applicant invites the Examiner to call the undersigned Greg Lefkowitz (561-671-3624 direct line) if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

Respectfully submitted,

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